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PD

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/837,301	04/11/97	STEVEN	A 08830/007001
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FISH & RICHARDSON
4225 EXECUTIVE SQUARE
SUITE 1400
LA JOLLA CA 92037

HM22/1101

EXAMINER

COOK, L

ART UNIT	PAPER NUMBER
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1641

8

DATE MAILED:

11/01/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/837,301

Applicant(s)

Alasdair C. Steven

Examiner

Lisa V. Cook

Group Art Unit

1641



☒ Responsive to communication(s) filed on Jun 29, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-56 is/are pending in the application

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-56 are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s) _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-21, drawn to a method of displaying a polypeptide on a surface lattice protein, classified in class 436, subclass 89.
 - II. Claims 22-36, drawn to a method of displaying a polypeptide on the surface of a virion, classified in class 435, subclass 69.1.
 - III. Claims 37-42, drawn to a method of immunizing a mammal with an antigenic composition, classified in class 424, subclass 184.1.
 - IV. Claims 43-47, drawn to a therapeutic composition, classified in class 514, subclass 2.
 - V. Claims 51-55, drawn to a chimeric polypeptide that binds to a surface lattice protein and a protein of interest, classified in class 435, subclass 235.1 and in class 536, subclass 24.1.
 - VI. Claims 48-50 and 56, drawn to an encoding nucleic acid molecule, classified in class 536, subclass 25.3.
2. The inventions are distinct, each from the other because of the following reasons:

Inventions I, II and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different

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functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case each of the method Groups are patentably distinct because Group I is drawn to polypeptide display via protein binding while, Group II is drawn to polypeptide display via binding of a virion and nucleic acid sequence encoding the polypeptide of interest. The method of Group III is further distinct because it is drawn to mammalian immunization. These methods all utilize different reagents, have different method steps, and detect different events.

3. Inventions V and I are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the polypeptide of Group V can be utilized as a reagent in inhibition assays.

4. Inventions VI and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the nucleic acid of Group VI may be used for processes other than the display of the polypeptide, such as nucleic acid hybridization assays or detection of an organism.

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5. Inventions IV and III are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). The antigenic polypeptide composition is not only useful in immunization but could be employed to produce specific antibodies or direct expression of a polypeptide in a mammalian host.

6. Inventions IV, V and VI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the each the products; the therapeutic composition of Group IV, the polypeptide of Group V, and the phage/nucleic acid of Group VI are biologically, chemically, and structurally different and therefore are patentably distinct.

7. Because these inventions are distinct for the reasons given above and have acquired separate status in the art as shown by their different classification, recognized divergent subject matter and because the search required for each invention is not substantially coextensive with the search required for the remaining invention, restriction for examination purposes as indicated is proper. Please note that the classifications in the restriction are illustrative only and do **not** represent all the classes and subclasses which must be searched for each invention; nor is the

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search limited to issued US patents, but rather includes published foreign patents and applications as well as literature search, which in this case would be divergent for each of the claimed inventions.

8. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

9. Should applicant traverse on the ground that the inventions are not patentably distinct, applicant is invited to submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

10. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I)

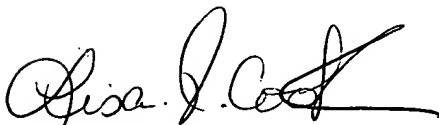
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11. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The Group 1641 Fax number is (703) 308-4242 which is able to receive transmissions 24 hours/day, 7 days/week.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lisa V. Cook whose telephone number is (703) 305-0808. The examiner can normally be reached on Monday-Friday from 8:00 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel, can be reached on (703) 308-4027.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

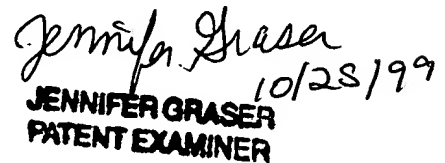


Lisa V. Cook

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CM1-7D16

October 26, 1999



JENNIFER GRASER
PATENT EXAMINER
10/28/99